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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,113	12/05/2003	Jeffery R. Parker	GLOLP0114USA	3167
7590 08/10/2005			EXAMINER	
Donald L. Otto Renner, Otto, Boisselle & Sklar, LLP 19th Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	
DATE MAILED: 08/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,113

Applicant(s)

PARKER ET AL.

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on May 31, 2005 has been entered. Claim 5 has been amended. No claim has been cancelled, or added. Claims 1-37 are still pending in this application, with claims 1, 10, 20 and 30 being independent.
2. The drawings were received on May 31, 2005. These drawings are acceptable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 10, 12-15, 18-21, 29, 30, 32-34 and 37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ASHALL (U.S. Pat. 5,390,436).
4. ASHALL discloses an illumination device having:
 - **a light redirecting film (as recited in claims 1, 10, 20 and 30),**
Figure 1, reference number 13;
 - **the film having a plurality of optical elements (as recited in claims 1, 10, 20 and 30),** column 2, lines 3-6;

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- **the optical elements being disposed in a pattern (as recited in claims 1, 10, 20 and 30), as seen in Figure 1;**
- **the pattern varying across the substrate (as recited in claims 20 and 30), column 2, lines 20-22;**
- **the pattern varies along the length of the substrate (as recited in claims 2 and 21), column 2, lines 20-22;**
- **the optical elements being small in relation to the size of the film (as recited in claims 10 and 30), as evidenced by Figure 1;**
- **the pattern varying at different locations on the film (as recited in claims 12 and 32), column 2, lines 20-22;**
- **at least some of the elements overlap, intersect or interlock each other (as recited in Claim 13), as evidenced in column 2, lines 34-39;**
- **at least some of the elements have different shapes (as recited in claims 14 and 33), column 2, lines 27-29;**
- **at least some of the elements have a different beam profile at different locations on the film (as recited in claims 15 and 34),**
inherent as produced by the varying distribution of the elements;
- **at least some of the elements vary in at least one of the slope angle, density, position, orientation, height or depth, shape, and size (as recited in claims 18 and 37), column 2, lines 23-26;**

- **at least some of the elements being arranged in groupings across the film (as recited in Claim 19), column 2, lines 23-26;**
- **at least some of the optical elements in at least some of the groupings having a different size or shape (as recited in Claim 19), column 2, lines 23-26;**
- **the size or shape of the elements of each group collectively producing an average size or shape characteristic for each group (as recited in Claim 19), column 2, lines 23-26;**
- **the average size or shape of the groupings varying across the film (as recited in Claim 19), column 2, lines 23-26;**
- **a back light member (as recited in Claim 29), Figure 1, reference number 10; and**
- **the film being applied to the back light member (as implied in Claim 29), column 3, lines 15-17.**

5. ASHALL fails to disclose a method for selecting the light redirecting film.

6. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made that the claimed method of selecting a light redirecting film was inherently disclosed by the structural limitations of the illumination device of ASHALL. However, even if the particular method presented by the claims is not considered as inherently disclosed by the patented structure of ASHALL, such method would have been considered an obvious matter of design choice as required by the

specific requirements of a particular application, such method having no impact on the final structure or characteristics of the claims optical film. Support for such finding of non-criticality of the method, is found in the applicant's own description, such description being silent as to the advantages of one method over another. In fact, applicant's disclosure is directed to the structure, and makes no mention at all of a particular method of selecting the light redirecting film.

7. Claims 10, 16, 30 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PARKER et al. (U.S. Pat. 5,618,096).

8. PARKER et al. discloses an illumination device having:

- **a light redirecting film (as recited in claims 10 and 30), Figure 4a, reference number 20;**
- **the film having a plurality of optical elements (as recited in claims 10 and 30), Figure 4a, reference number 21;**
- **the optical elements being disposed in a pattern (as recited in claims 10 and 30), column 4, lines 28-34;**
- **the optical elements being small in relation to the size of the film (as recited in claims 10 and 30), as evidenced by Figure 4a;**
- **at least some of the optical elements are randomly distributed on the film (as recited by claims 16 and 35), column 5, lines 45-58.**

9. PARKER et al. fails to disclose a method for selecting the light redirecting film.

10. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made that the claimed method of selecting a light redirecting film was inherently disclosed by the structural limitations of the illumination device of PARKER et al.. However, even if the particular method presented by the claims is not considered as inherently disclosed by the patented structure of PARKER et al., such method would have been considered an obvious matter of design choice as required by the specific requirements of a particular application, such method having no impact on the final structure or characteristics of the claims optical film. Support for such finding of non-criticality of the method, is found in the applicant's own description, such description being silent as to the advantages of one method over another. In fact, applicant's disclosure is directed to the structure, and makes no mention at all of a particular method of selecting the light redirecting film.

11. Claims 3, 4, 7, 11, 17, 22, 23, 26, 31 and 36 rejected under 35 U.S.C. 103(a) as being unpatentable over ASHALL (U.S. Pat. 5,390,436) in view of MIZOBE (U.S. Pat. 5,641,219).

12. ASHALL discloses, or suggests, all the limitations of the claims as detailed in sections 4-6 of the instant Office Action, except:

- the pattern varying along the width of the film (as recited in claims 3 and 22);
- the pattern varying along both the length and width of the film (as recited in claims 4 and 23);
- the pattern being a repeating pattern on the film (as recited in claims 7, 11, 26 and 31); and
- at least some of the optical elements are oriented at different angles on the film (as recited in claims 17 and 36).

13. MIZOBE discloses an illumination device having:

- **a substrate**, Figure 4, reference number 1;
- **a light source**, Figure 4, reference number 6;
- **optical elements**, Figure 4, reference number 3;
- **the optical elements being located on a surface of the substrate**, column 3, lines 46-51;
- **the elements forming a pattern**, as seen in figures 4-6;
- **the pattern varying along the length of the film**, column 4, lines 19-23;
- **the pattern varying along the width of the film (as recited in claims 3 and 22)**, column 4, lines 24-30;
- **the pattern varying along both the length and width of the film (as recited in claims 4 and 23)**, as seen in figures 4-6; and

- **at least some of the optical elements are oriented at different angles on the film (as recited in claims 17 and 36), as seen in figures 5 and 6.**

14. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to vary the pattern along the width of the film (as recited in claims 3 and 22), or both the length and width of the film (as recited in claims 4 and 23) to compensate for the distribution of light across the surface of the light source and further increase the uniformity of the light produced by the film, as per the teachings of MIZOBE (column 4, lines 24-40).

15. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to orient at least some of the optical elements at different angles on the film (as recited in claims 17 and 36) to compensate for the angular displacement as well as the longitudinal displacement of the optical elements with respect to the location of the light source, even further increase the uniformity of the light produced by the film, as per the teachings of MIZOBE (column 4, lines 59-65).

16. Claims 5, 6, 8, 9, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ASHALL (U.S. Pat. 5,390,436).

17. ASHALL discloses, or suggests, all the limitations of the claims as detailed in Section 7 of the instant Office Action, except:

- the film being formed in a roll (as recited in claims 5, 8, 24 and 27);
- the selected area being removed from the film roll (as recited in claims 5, 8, 24 and 27); and
- the selected area being die-cut from the length of the film (as recited in claims 6, 9, 25 and 28).

18. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to form the film in a roll (as recited in claims 5, 8, 24 and 27) with the selected area being removed such film roll (as recited in claims 5, 8, 24 and 27) by die-cutting (as recited in claims 6, 9, 25 and 28), as such method of forming and cutting films is not only old and well known, but standard in the art. One would have been motivated to be able to form such film in a continuous strip easy to store and transport, and from which strip desired shapes and sizes could be cut as required by a particular application.

Response to Arguments

19. Applicant's arguments filed May 31, 2005 have been fully considered but they are not persuasive.

20. Regarding the Examiner's rejection of claims 1, 10, 20 and 30 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either ASHALL (U.S. Pat. 5,390,436) or PARKER et al. (U.S. Pat. 5,618,096), the

applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically a method for, having a light redirecting film having a pattern of optical elements that varies, selecting an area of such film that best suits a particular application, and removing the selected area.

21. Regarding the Examiner's rejection of claims 5, 6, 8, 9, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ASHALL (U.S. Pat. 5,390,436), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the film being formed in a roll and the selected area being die-cut from the film roll. In addition, the applicant argues that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, and that there is insufficient factual support for such obviousness conclusion.

22. Regarding the Examiner's rejection of claims 2-4, 7, 11-19, 21-23, 26, 29 and 31-37 the applicant present no arguments, except stating that such claims depend directly or indirectly from independent claims 1, 10, 20 or 30, and would be allowable when/if the independent claims are allowed.

23. In response to applicant's arguments that both ASHALL and PARKER et al. failed to individually disclose or suggest the claimed method, the applicant is respectfully directed to sections 3-6 (ASHALL) and 8-10 (PARKER et al.) of the instant Office Action, where the cited references are discussed in detail.

ASHALL discloses a light redirecting film having all the structural limitations of the claimed invention, such film 13 including a plurality of optical elements disposed on a surface of the film with a variable density, the film 13 being provided to a panel 10 for evenly redirecting light from a light source over the surface of the panel 10. While no method of selecting such film is explicitly discussed, one of ordinary skill in the art would have recognized that the before providing the film to the panel one would had to select the appropriate film 13 before applying it to the panel 10.

In addition, it is once again noted that the instant specification is silent as to one method of such selection, or the advantages of one method over another. Applicant's cites page 14, lines 6-10 (of the specification as filed) as disclosing the claimed method, however, such passage merely suggests (e.g. "may be provided") providing the film with a repeating pattern of optical devices to permit a selected area to be cut, and clearly fails to support one method over another different method.

24. In response to applicant's arguments that both ASHALL and PARKER et al. failed to individually disclose or suggest the film being formed in a roll and the selected area being die-cut from the film roll, the applicant is respectfully directed to sections 17 and 18 of the instant Office Action, where such limitations are discussed and the rationale supporting the rejection is detailed.

25. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, as previously stated, forming the light redirecting film of ASHALL in a roll with the selected area being removed such film roll would have flown naturally to one of ordinary skill in the art at the time of invention, to be able to form such film in a continuous strip easy to store and transport, and from which strip desired shapes and sizes could be cut as required by a particular application. In addition, as the applicant would no doubt agree, forming films in rolls is not only old and well known in the arts, but a preferred method of forming films.

Conclusion

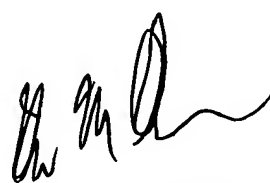
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


Inr

August 5, 2005


THOMAS M. SEMBER
PRIMARY EXAMINER